

REMARKS

Claims 1 through 20 remain in this application. Claims 21 through 34 are currently withdrawn due to a restriction requirement. Claims 1 and 20 are amended above.

Applicants thank the Examiner for his approval of the June 12, 2006 Declaration. To my knowledge, the material attached to the Declaration was an internal Technical Requirements Specification and not published in a printed publication prior to filing of the patent application.

Claim Rejections under 35 U.S.C. § 112

The Office Action rejected claims 1 through 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that claim 1, line 4, “physical” is not clear as to its meaning and the claim 20, line 6, “physical” is not clear as to its meaning.

Applicants note that these words were in the original claims, and no prior Office Actions have included such a rejection or felt that the words were indefinite. Furthermore, the claims meet all the requirements of 35 U.S.C. § 112, second paragraph. “Determining whether a claims is definite requires an analysis of ‘whether one skilled in the art would understand the bounds of the claim when read in light of the specification . . . If claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.’” *Personalized Media Communications, LLC v. U.S. Int’l Trade Comm’n*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998) (citing *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) and finding that term digital detector is definite because the written description of the specification was sufficient to inform one skilled in the art of the meaning of the claim language). Moreover, the term “physical” in claims 1 and 20 are clearly described in the specification. Thus, a person of skill in the art would clearly understand the bounds of claims 1 and 20 when read in light of the specification.

However, the term “physical” has been removed from claims 1 and 20 to further broaden the claims and more clearly define the invention.

Claim Rejections under 35 U.S.C. 103(a) over the Johnson reference

The Office Action rejected Claims 1 through 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,712,989 to Johnson et al. (the Johnson reference). However, the rejection fails to show how the Johnson reference discloses or suggest the requirements of the claims.

Independent Claim 1 and dependent claims 2 through 19

First, the Office Action states that, “Johnson discloses a communication network system comprising an asset manager, e.g. inventory database, off-line, e.g. distributor list price, and on-line assets, e.g. database 20, 50, e.g. inventory 52, 54, an information link, e.g. 10.” However, these are not the requirements of the claims. Claim 1 states, “assigning system-readable identification to an asset item of a communication network; receiving, at an asset manager, said system-readable identification of the asset item in response to installing the asset item in the communication network; and creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item, wherein said system-readable identification enables the asset manager to create the informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.” The Johnson reference fails to teach or suggest the requirements of claim 1.

For example, *inter alia*, the Johnson reference fails to teach or suggest the element of claim 1 of, “receiving, at a physical asset manager, said system-readable identification of the asset item in response to installing the asset item in the communication network.” The Johnson reference nowhere discloses receiving such a system readable identification of an asset item in response to installing an asset item in a communication network. The Johnson reference is merely a requisition and inventory management system as stated at column 1, lines 5 through 6. In addition, the Johnson reference also fails to teach or suggest the element of claim 1 of, “creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item, wherein said system-readable identification enables the physical asset manager to create the informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.” The Office Action states that it has on-line assets, e.g. database 20, 50, e.g. inventory 52, 54, an information link, e.g. 10. However, the database 20 is a host database of Products stocked by a Distributor, as stated at column 3 lines 10-15, and

database 50 is a local database of items stored in a JIT facility such as a warehouse, as described at column 4, lines 23 through 26. None of these databases lists “on-line network equipment” installed in a network or creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item.

Second, the Office Action states in paragraph 5 that: “Official Notice that a physical asset manager has been common knowledge in the art.” The Applicants respectfully traverse the Official Notice. As explained in the specification on page 1, lines 18 through 25, in conventional network management systems, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability. A first physical equipment inventory management application is used for managing on-line network equipment and a second physical equipment inventory management application is used for managing off-line network equipment.” Thus, the statement, “a physical asset manager has been common knowledge in the art,” is only true to the extent such physical asset manager is used only for managing on-line network equipment or such physical asset manager is used only for managing off-line network equipment. Applicants respectfully request documentary evidence in the next Office Action of what he deems to be common knowledge in the art with respect to “a physical asset manager.”

Next, the Office Action states that, “To have provided such for Johnson would have been obvious to one of ordinary skill in the art. The motivation for having done such would have been to implement a common knowledge management system.” Such motivation is only taught by the present specification. “The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings.” *Application of Nomiya*, 184 U.S.P.Q. 607, 612 (Cust. & Pat.App. 1975). The citation of the specification’s own teachings to argue obviousness over prior art is improper. *In re Dembiczak*, 175 F.3d 994, 999, (criticizing hindsight syndrome wherein that which only the inventor taught is used against the teacher).

As explained in the specification on page 1, lines 18 through 25, in conventional network management systems, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability. A first physical equipment inventory management application is used for managing on-line network equipment

and a second physical equipment inventory management application is used for managing off-line network equipment.” The present invention realizes the shortcomings of the conventional network management systems and states on page 1, lines 23 through 25, “Without the functionality of these two physical equipment inventory management applications being integrated, the ability to effectively optimize the planning and utility of network equipment is limited.” Thus, the specification teaches on page 1, lines 27 through 29, “integrating inventory management of on-line and off-line communications network equipment is useful for facilitating and planning and utility of network equipment in a cost effective manner.” Since this motivation of integrating inventory management of on-line and off-line communications network equipment is only taught by the present specification, it is improper to use appellant's teachings’ to add to the failings of the Johnson reference to meet the requirements of the claims.

For the above reasons, the Johnson reference fails to teach or suggest the requirements of independent claim 1.

Independent Claim 20

Independent Claim 20 states, “assigning a serial number and a part number to an asset item of a communication network, wherein the serial number and the part number are electronically stored on an electronic element of the asset; receiving, at an asset manager, the serial number and the part number of the asset item to an asset manager in response to installing the asset item in the communication network; performing an informational binding operation for associating information retrievable from an on-line persistent asset database with corresponding information retrievable from an off-line asset inventory database, wherein said system-readable identification enables the asset manager to create an informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item; enabling the display of a physical asset management view of an object corresponding to the asset item in response to creating the informational link, wherein the on-line sub-object of the asset item and the off-line sub-object of the asset item are capable of being integrally viewed in the asset management view; and preparing network planning information after creating the informational link.” The Johnson reference fails to teach or suggest the requirements of claim 20.

For example, *inter alia*, the Johnson reference fails to teach or suggest the element of claim 20 of, “receiving, at an asset manager, the serial number and the part number of the asset

item to an asset manager in response to installing the asset item in the communication network.” The Johnson reference nowhere discloses receiving such a system readable identification of an asset item in response to installing an asset item in a communication network. The Johnson reference is merely a requisition and inventory management system as stated at column 1, lines 5 through 6. In addition, the Johnson reference also fails to teach or suggest the element of claim 20 of, “performing an informational binding operation for associating information retrievable from an on-line persistent asset database with corresponding information retrievable from an off-line asset inventory database, wherein said system-readable identification enables the asset manager to create an informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.” The Office Action states that it has on-line assets, e.g. database 20, 50, e.g. inventory 52, 54, an information link, e.g. 10. However, the database 20 is a host database of Products stocked by a Distributor, as stated at column 3 lines 10-15, and database 50 is a local database of items stored in a JIT facility such as a warehouse, as described at column 4, lines 23 through 26. None of these databases lists “on-line network equipment” installed in a network or an informational binding operation for associating information retrievable from an on-line persistent asset database with corresponding information retrievable from an off-line asset inventory database.

Second, the Office Action states in paragraph 5 that: “Official Notice that a physical asset manager has been common knowledge in the art.” The Applicants respectfully traverse the Official Notice. As explained in the specification on page 1, lines 18 through 25, in conventional network management systems, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability. A first physical equipment inventory management application is used for managing on-line network equipment and a second physical equipment inventory management application is used for managing off-line network equipment.” Thus, the statement, “a physical asset manager has been common knowledge in the art,” is only true to the extent such physical asset manager is used only for managing on-line network equipment or such physical asset manager is used only for managing off-line network equipment. Applicants respectfully request documentary evidence in the next Office Action of what he deems to be common knowledge in the art with respect to “a physical asset manager.”

Next, the Office Action states that, “To have provided such for Johnson would have been obvious to one of ordinary skill in the art. The motivation for having done such would have been to implement a common knowledge management system.” Such motivation is only taught by the present specification. “The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings.” *Application of Nomiya*, 184 U.S.P.Q. 607, 612 (Cust. & Pat.App. 1975). The citation of the specification's own teachings to argue obviousness over prior art is improper. *In re Dembiczak*, 175 F.3d 994, 999, (criticizing hindsight syndrome wherein that which only the inventor taught is used against the teacher).

As explained in the specification on page 1, lines 18 through 25, in conventional network management systems, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability. A first physical equipment inventory management application is used for managing on-line network equipment and a second physical equipment inventory management application is used for managing off-line network equipment.” The present invention realizes the shortcomings of the conventional network management systems and states on page 1, lines 23 through 25, “Without the functionality of these two physical equipment inventory management applications being integrated, the ability to effectively optimize the planning and utility of network equipment is limited.” Thus, the specification teaches on page 1, lines 27 through 29, “integrating inventory management of on-line and off-line communications network equipment is useful for facilitating and planning and utility of network equipment in a cost effective manner.” Since this motivation of integrating inventory management of on-line and off-line communications network equipment is only taught by the present specification, it is improper to use appellant's teachings’ to add to the failings of the Johnson reference to meet the requirements of the claims.

For the above reasons, the Johnson reference fails to teach or suggest the requirements of independent claim 20.

Claim Rejection under 35 U.S.C. 103(a)

The Office Action rejected Claims 1 through 20 under 35 U.S.C. 103(a) as being unpatentable over, “Applicant’s prior art disclosure, e.g. June 12, 2006 Amendment referencing

Applicant's specification page 1, lines 18-25." Such June 12, 2006 Amendment is not a prior art disclosure as it was filed after the filing of this patent application on April 11, 2001. So such disclosure is not prior art.

CONCLUSION

For the above reasons, the foregoing amendment places the Application in condition for allowance. Therefore, it is respectfully requested that the rejection of the claims be withdrawn and full allowance granted. Should the Examiner have any further comments or suggestions, please contact Jessica Smith at (972) 477-9109.

Respectfully submitted,
ALCATEL

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/Jessica W. Smith/

Jessica W. Smith
Reg. No. 39,884

Alcatel USA
Intellectual Property Department
3400 W. Plano Parkway, M/S LEGL2
Plano, TX 75075
Phone: (972) 477-9109
Fax: (972) 477-9328